UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,204	06/26/2001	Naoyuki Fujisawa	1538.1015	9335

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EXAMINER
LASTRA, DANIEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Office Action Summary	Application No. 09/891,204	Applicant(s) FUJISAWA ET AL.
		Examiner DANIEL LASTRA	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09/30/2005</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-19* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1. Claims 1-19 have been examined. Application 09/891,204 has a filing date 06/26/2001 and foreign data 02/22/2001.

Response to Amendment

2. In response to Final Rejection filed 05/31/2005, the Applicant filed an RCE on 09/30/2005, which amended claims 1, 7 and 13. Applicant's amendment overcame the Section 112 rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 7 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 7 and 13 recite "without judging whether or not said packet data is the registered particular packet data". Nowhere, in the Applicant's specification, said limitation is mentioned or described.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 7 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. Claims 1, 7 and 13 recite "wherein said

charging is carried out without judging whether or not said packet data is the registered

particular packet data". Nowhere, in Applicant's specification, said limitation is

described or explained. The Examiner would interpret said limitation as meaning

charging a registered sender for a particular send packet data.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-9, 11-15 and 17-19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Meuronen (U.S. 6,473,622).

As per claims 1, 7, 13 and 19 Meuronen teaches:

A method for transferring a communication fee, comprising:

registering into a transmitting information storage device, information regarding

destination users, a sender, and a particular packet data to be sent (see column 1, lines

16-33; column 3, lines 35-42);

when a terminal of said destination user registered in said transmitting

information storage device performs a processing to receive packet data, charging said

destination user for said packet data (see column 1, lines 1-16; column 5, lines 1-15),

wherein said charging is carried out without *judging whether or not said packet data is registered particular packet data* (see column 6, lines 19-36; column 7, lines 15-24); and

transferring the communication fee charged to said destination users for said particular packet data, to said sender registered in said transmitting information storage device, by using a receiving status data for said particular packet data to be received by said terminals of said destination users registered in said transmitting information storage device (see column 2, lines 60-67; column 7, lines 14-24),

wherein a number of packets of said particular packet data is calculated from said particular packet data stored in said transmitting information storage device (see column 6, lines 19-35; column 7, lines 13) but does not expressly teach and an amount of the transferred communication fee is calculated by using a number of destination users specified by said receiving status data, and said number of packets of said particular packet data. Meuronen teaches in column 7, lines 13-23 "information on the fact that chargeable information was concerned directed the billing associated with the short message to the subscriber, but it is obvious to those skilled in the art that by the solution of the invention, billing may also be directed to another address. For example an ad that the subscriber is prepared to receive, could be directed to a third address by means of the described solution by adding parameters, whereby the advertiser would have to pay only for information relayed by an operator and received directly by a customer". Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the advertisers' fees charge for

transmitting messages to destination users would be directly proportional to the number of messages (i.e. packet data) that are delivered to said destination users. The bigger the number of messages sent by said advertisers that are relayed by an operator and received directly by said destination users, the more said advertisers (i.e. sender) would have to pay to cover the expenses of said distribution.

As per claims 2, 8 and 14, <u>Meuronen</u> teaches:

The method set forth in claim 1, further comprising:

charging said sender for said particular packet data when said particular packet data is transmitted to the destination users registered in said transmitting information storage device (see column 7, lines 13-24).

As per claims 3, 9 and 15, <u>Meuronen</u> teaches:

The method set forth in claim 1, wherein said registering comprises:

registering information regarding said sender and said particular packet data to be sent into said transmitting information storage device; and registering information regarding said destination users into said transmitting information storage device (see column 3, lines 35-42; column 7, lines 13-24).

As per claims 5, 11 and 17, <u>Meuronen</u> teaches:

The method set forth in claim 1, wherein said transferring comprises:

performing a processing to exempt particular destination users whose terminals are confirmed to have performed said processing to receive said particular packet data among said destination users registered in said transmitting information storage device from the charge for said particular packet data (see column 5, lines 1-15); and

performing a processing to charge said sender registered in said transmitting information storage device for a fee of said particular packet data for said particular destination users whose terminals are confirmed to have performed said processing to receive said particular packet data among said destination users registered in said transmitting information storage device (see column 7, lines 13-25).

As per claims 6, 12 and 18, Meuronen teaches:

The method set forth in claim 3, wherein said transferring further comprises:

acquiring data regarding said particular packet data which does not reach (see column 7, lines 13-25); and

specifying destination users who is confirmed to have performed said processing to receive said particular packet based on said data regarding said packet which does not reach (see column 7, lines 13-25).

4. Claims 4, 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meuronen (U.S. 6,473,622) in view of Jacobs (US 2004/0039784).

As per claims 4, 10 and 16, Meuronen teaches:

The method set forth in claim 3, but fails to teach wherein said particular packet data includes a Web page data, and said registering information regarding said destination users includes a step of registering information regarding said destination user that is acquired when a terminal of said destination user requests said particular packet data. However, Jacob teaches a system where users request and receive e-mails and advertisements using said users' mobile terminals (i.e., cellular phones with

built-in web browsers; see paragraph 31). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meuronen would use the system taught by Jacob to allow users of mobile terminals to request and receive e-mails and advertisements in said mobile terminals, where the sender (i.e. advertiser) and not the receiver (i.e. destination user) of said advertisements would be billed for said distribution, as taught by Meuronen. Charging the sending party (i.e. advertiser) instead of the receiving party (i.e. destination user) in a mobile communication system would make said receiving party more willing to accept data from said sending party.

Response to Arguments

5. Applicant's arguments filed 09/30/2005 have been fully considered but they are not persuasive. The Applicant argues that Meuronen does not teach charging based on a "packet". The Examiner answers that Applicant's specification defines "packets" in page 4, paragraph 2 that packet data includes "advertisements. Meuronen teaches in column 7, lines 15-25 charging advertisers for ads (i.e. packets) send to subscribers. Therefore, Meuronen teaches packets, as defined by Applicant's specification.

The Applicant argues that Meuronen does not teach charging by a number of packets. The Examiner answers that Meuronen bills subscribers and/or advertisers for each short digital message (i.e. packet) sent to said subscribers. Therefore, in Meuronen, the more messages send to subscribers, the more Meuronen would bill advertisers or subscribers for each additional packets sent to said subscribers.

Therefore, <u>Meuronen</u> is charging by a number of packets sent to destination users, similar to Applicant's claimed invention.

The Applicant argues that <u>Meuronen</u> does not teach a destination user, a sender and particular packet to be sent. The Examiner answers that <u>Meuronen</u> teaches in column 7, lines 13-23 a subscriber (i.e. destination user), an advertiser (i.e. sender) and a particular packet (i.e. advertisement), similar to Applicant's claimed invention.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
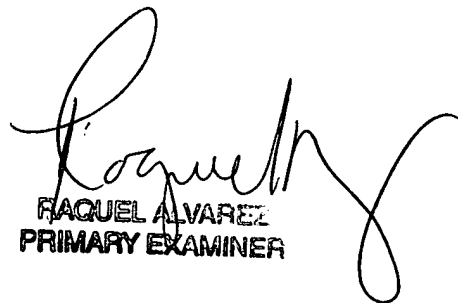
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
November 21, 2005

RAQUEL ALVAREZ
PRIMARY EXAMINER